

REMARKS

By this reply, no amendments to the claims have been made. Accordingly, claims 1-38, 40-47, 49-58, 76-82, 84, 86-89, and 133-136 remain pending in this application. No new matter has been introduced by this reply.

As an initial matter, Applicant thanks the Examiner for withdrawing the finality of the previous Office Action.

In the outstanding Office Action, claims 1-38, 40-47, 49-58, 76-82, 84, 86-89, and 133-136 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,743,154 to James et al. ("James") in view of U.S. Patent No. 4,049,130 to Bell ("Bell").

Applicant respectfully traverses this rejection for the reasons set forth below.

The Prior Art

James discloses a pallet inspection and repair system including a vertically reciprocating lift table 19, and a pallet discharge conveyor 23 that includes a plurality of drive chains 121,122, and 123. See James, col. 4, Ins. 28-37. Each of the drive chains 121, 122, and 123, carries a lug 132 that engages the back end of a pallet placed on lift table 19. See *Id.* at col. 7, Ins. 14-16 and 40-52; and FIG. 3.

James fails to teach or suggest a cantilevered pusher bar or arm, "having a pallet contacting portion that is vertically spaced away from the platform when the pusher bar is in a dispensing position, such that there is a gap between the pallet contacting portion and the platform," as required by each of independent claims 1, 23, 53, 76, and 86. On page 2 of the Office Action, the Examiner acknowledges the deficiency in James by stating that James, "does not specifically disclose means for adjusting the size of an

interior of the pallet magazine, nor does it disclose the pusher being spaced above the platform surface."

In an attempt to cure the deficiencies of James, Bell is cited. Bell discloses an apparatus for counting yieldable flat articles such as paperback books, wherein,

"[S]tructure is provided for imposing a longitudinally directed pressure load . . . on the stacks S . . . so that the mechanism (later described) slicing the books from the stack S can be calibrated or adjusted to slice off a given number of books per slice . . . A known quantity of books is sliced from the lower ends of the stacks S by horizontally movable counting-by-measuring structure including vertically extending pushers 22 . . . The operation of pushers 22 is such as to place the measured (counted) stacks on to a platform 28."

Bell, col. 1, Ins. 52-54; and col. 2, Ins. 8-25. On page 3, the Office Action asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of JAMES ET AL by adding the pusher of BELL in order to achieve the greater pushing force made possible by a pneumatic pusher."

Applicant disagrees with this assertion, and submits that the rejection based on James and Bell is improper for at least the reasons provided below.

Bell is Non-Analogous Art

In explaining the distinction between analogous and non-analogous art, the M.P.E.P. recites the following:

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

M.P.E.P. § 2141.01(a). Applicant's field of endeavor is pallet dispensing. In contrast, Bell's field of endeavor is "counting yieldable flat articles," i.e., books. Bell, Abstract. Bell has nothing to do with pallet dispensing, and thus, Bell is not in the field of

Applicant's endeavor. Therefore, the only way that Bell may be relied upon as a basis for rejection is if Bell is reasonably pertinent to the particular problem with which Applicant was concerned. Bell, however, is not reasonably pertinent to the particular problem with which Applicant was concerned, that is, providing advantages and obviating problems associated with earlier pallet dispensers. See Applicant's specification, page 4, paragraph [009]. Instead, the problem to which Bell is directed is the counting of books, which is not at all pertinent to pallet dispensing. See Bell, col. 1, Ins. 6-16. Since Bell is not in the field of Applicant's endeavor, and is not pertinent to the problem with which Applicant was concerned, Bell is non-analogous art, and reliance on Bell as a basis for the rejection of Applicant's claims is improper.

Reconsideration is requested.

The Rejection Fails to Meet the Criteria for Establishing a *Prima Facie* Case of Obviousness

The rejection based on James and Bell fails to meet the criteria for establishing a *prima facie* case of obviousness. In regard to obviousness, the M.P.E.P. recites the following:

"To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2143.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01.

Applicant submits that there would be no motivation to modify James, which already has lug 132 for pushing pallets, to include yet another pushing mechanism, pusher 22 of Bell, as suggested on page 3 of the Office Action. To do so would be redundant. Lug 132 of James already pushes pallets, and adding pusher 22 of Bell to push the pallets would add cost and complexity to the apparatus in James, while serving no apparent function or purpose.

While page 3 of the Office Action recites the motivation for combining James and Bell as being, "to achieve the greater pushing force made possible by a pneumatic pusher," Bell does not teach or suggest such a motivation. Further, as James moves only one pallet at a time, in order to permit each pallet to be individually inspected, no additional pushing force would be desirable in the device of James. Thus, one of ordinary skill would not be motivated to modify James with Bell for such a purpose. In Bell, the alleged greater pushing force made possible by pusher 22 is desirable for overcoming the compressive force on the books exerted by a pressure cylinder 17. See Bell, col. 2, Ins. 1-7. No such compressive force exists in James. In James, the pallet P1 in FIGS. 9-12, is already separated from pallets P2-P5 prior to being dispensed, and thus, there is no compressive force on P1. Since there is no compressive force on P1 in James, the need for pushers 22 of Bell to overcome compressive forces does not exist, and so one of ordinary skill would not have been motivated to add pushers 22 to James. Applicant respectfully submits that since there is no teaching or motivation to combine James and Bell to arrive at the claimed invention, any such combination is impermissible hindsight.

Furthermore, in James, forks 21 and 22 are “driven into openings 8 between stringers in the pallet The lift table 19 is then lowered . . . carrying with it the lowermost pallet 301 of the stack, the remaining pallets 302-305 of the stack being suspended by the extended forks 21 and 22. The pallet P1 removed from the stack is then driven off the lift table 19 by the pallet discharge conveyor 23 onto the pallet inspection table 15 (FIG. 1).” James, col. 4, Ins. 53-55 and 62-68, and col. 5, In. 1. By stripping one pallet at a time from the stack, James provides an operator with the ability to inspect the top and bottom surfaces of pallet P1. See *Id.* at Abstract and col. 10, Ins. 10-20. In addition, the lug 132 is sized to engage the pallet to be moved without interfering with the remaining pallets 302-305 that are suspended directly above the pallet to be moved. Bell, however, teaches pushers 22 that remove several articles at a time from stack S. Bell, FIGS. 4-6. Thus, if pushers 22 of Bell were added to James, they would move not only pallet P1, but also interfere with remaining pallets 302-305, possibly moving more than one pallet at a time or causing damage to the pallets 302-305 remaining in the stack due to friction between the stacked pallets. This is a problem that the present invention addresses and overcomes. Moving more than one pallet would destroy the operator’s ability to inspect the top and bottom surfaces of pallet P1, rendering the system in James unsatisfactory for its intended purpose of pallet inspection and repair. Moving pallets away from the stack may damage the pallets, also rendering a modified James unsatisfactory. Since the Examiner’s proposed modification of James with Bell would render James unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the Examiner’s proposed modification. See M.P.E.P. 2143.01.

On page 2 of the Office Action, the Examiner asserts that “the claimed ‘cantilevered pusher bar’ is being read on the pusher lugs of JAMES ET AL, since they are held rigidly on the end secured to the conveyor and extend outward to engage the pallet.” However, the pallet contacting portion of lug 132 of James is not vertically spaced away from the platform, and no gap exists between the pallet contacting portion of lug 132 and the platform. Therefore James certainly fails to disclose or suggest a cantilevered pusher bar or arm “having a pallet contacting portion that is vertically spaced away from the platform when the pusher bar is in a dispensing position, such that there is a gap between the pallet contacting portion and the platform,” as required by independent claims 1, 23, 53, 76, and 86. Adding pushers 22 of Bell to James does not change or modify lug 132 in any way, and so the teachings of Bell fail to remedy this deficiency of James. Further, Applicant cannot see a benefit to simply “adding the pusher of BELL,” as suggested by the Examiner on page 3 of the Office Action. If the pusher of Bell is used to supplement lug 132 of James, as the Office Action seems to suggest, then the pusher would contact lug 132 and not the pallet, thus providing no benefit associated with the pusher 22.

For all of the above reasons, James and Bell, whether alone or in combination, is not sufficient to render independent claims 1, 23, 53, 76, and 86 *prima facie* obvious. Accordingly, Applicant requests withdrawal of the rejection of independent claims 1, 23, 53, 76, and 86, and request the timely allowance thereof.

Applicant also respectfully traverses the rejection of independent claims 80 and 133 as being unpatentable over James in view of Bell. Independent claims 80 and 133 recite, *inter alia*, “building a load on the dispensed pallet; providing relative

rotation between a packaging material dispenser and the load to wrap packaging material around the load." On page 4, the Office Action contends that,

"it would have been obvious to one of ordinary skill in the art at the time the invention was made to load the pallets and wrap the load as claimed, holding loads is a primary function of pallets and wrapping loads is well known in the art."

However, according to the M.P.E.P.,

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."

M.P.E.P. § 2143.03. Applicant submits that the Examiner has failed to establish *prima facie* obviousness because all of the claim limitations recited in independent claims 80 and 133 are not taught or suggested by James and Bell. James actually teaches against loading the pallet and wrapping the load. For example, James discloses that,

"[T]he pallet P1 removed from the stack is then driven off the lift table 19 by the pallet discharge conveyor 23 onto the pallet inspection table 15 (FIG. 1)," and "a pallet positioned on the table top is up-ended (see FIG. 6A). The operator can pivot the pallet manually about its lower end to inspect or repair the pallet The pallet can easily be 'flipped' over by the operator."

James, col. 4, Ins. 66-68; col. 5, ln. 1; and col. 10, Ins. 9-11 and 15. Building a load on pallet P1 and wrapping the load with packaging material would destroy the operator's ability to pivot pallet P1, flip pallet P1, and/or inspect pallet P1. Accordingly, neither James nor Bell teaches or suggests all of the claim limitations recited in independent claims 80 and 133, and thus, the Examiner has failed to establish *prima facie* obviousness for rejecting these independent claims.

Furthermore, Applicant respectfully submits that since there is no teaching or motivation to combine James and Bell to arrive at the claimed invention, any such combination would be impermissible hindsight.

For all of the above reasons the teachings of James and Bell are not sufficient to render independent claims 80 and 133 *prima facie* obvious. Accordingly, Applicant requests withdrawal of the rejection of independent claims 80 and 133, and request the timely allowance thereof.

Claims 2-22, 24-38, 40-47, 49-52, 54-58, 77-79, 81, 82, 84, 87-89, and 134-136 depend either directly or indirectly from one of independent claims 1, 23, 53, 76, 80, 86, and 133, and are therefore allowable for at least the same reasons that independent claims 1, 23, 53, 76, 80, 86, and 133 are allowable. In addition, at least some of these claims recite unique combinations that are neither taught nor suggested by the cited art, and are therefore also separately patentable.

For example, claim 14 recites, *inter alia*, "a pusher carrier rotatably attached to the pusher bar." Claim 15 recites, *inter alia*, "a palletizer disposed adjacent the pallet dispenser." Claim 18 recites, *inter alia*, "a sensor associated with the pusher bar, the sensor being adapted to determine a jam condition of the lowermost pallet; and a controller for activating the motion means when the sensor determines the jam condition." These features are not disclosed by either James or Bell, and the Office Action is silent as to how James and Bell can be used to teach or suggest these features. Numerous other dependent claims have also been rejected using the combination of James and Bell without having been addressed in the Office Action. Accordingly, Applicant requests that should these rejections be maintained, the Examiner provide a new Office Action containing an explanation of how James and Bell are being applied to each dependent claim so that Applicant at least has the opportunity to respond.

Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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